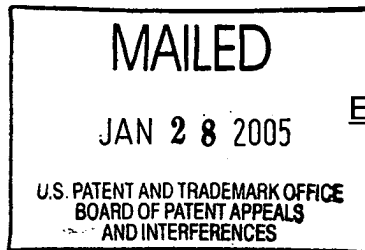


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte VLAD ZAHARIA and PEDRO S. BARANDA

Appeal No. 2004-0837
Application No. 09/778,481

ON BRIEF

Before GARRIS, PAK, and JEFFREY SMITH, Administrative Patent Judges.
PAK, Administrative Patent Judge.

REQUEST ON REHEARING

Appellants request a rehearing of the Board's decision entered June 8, 2004, wherein we affirmed the examiner's decision rejecting claims 1 through 22 under 35 U.S.C. § 103.

In the Request for Rehearing dated August 19, 2004, the appellants argue (pages 1 and 2) that:

There are several points that Applicant believes to have been misapprehended or overlooked when rendering the Decision on Appeal. First, the "Official Notice" taken in the decision does not comply with MPEP 2144.03 and the cases cited in that section. Second, various statements of the Examiner were considered "undisputed" even though Applicant contested the rejections in their entirety. Third, the "dispositive question" described in the decision is only dispositive if decided in Applicant's favor but when decided in the manner stated in the decision, requires further analysis at a minimum.

We have carefully considered these arguments. However, we are not convinced that any reversible error was made in our decision entered June 8, 2004.

First, as pointed out by the appellants, we took official notice at page 13 of our decision that one of ordinary skill in the art using a sensor for monitoring and detecting defects in elevator ropes "would have monitored the portions of the rope[s], which were subject to the highest stress (e.g., the portion[s] of the rope[s] subject to continuous bending, especially at an extreme bending angle...[portions of the ropes most likely to damage during the ordinary use]) under the worst case loading scenario to prevent catastrophic accidents." Rather than arguing the correctness or the veracity of the facts of which we took official notice, the appellants only argue that this official notice "does not comply with MPEP 2144.03 and cases cited in that section." See the Request for Rehearing, page 2. Specifically, the appellants argue that the facts of which we took official notice are not capable of instant and unquestionable demonstration as being well

known and cannot be relied on absent some documentary proof. See the Request for Rehearing, pages 2-5.

We are not persuaded by this argument. As indicated *supra*, the appellants do not dispute correctness or veracity of the facts of which we took official notice. As such, we concur with the examiner that a sensor for detecting defects in elevator ropes, of necessity, would be placed at a location for detecting portions of the ropes most likely to be damaged or worn. To hold otherwise is to accept the appellants' implicit argument that one skilled in the art using a sensor for monitoring and/or detecting defects or damages in elevator ropes during their normal usage would place the sensor at a location where it would not monitor or detect defects or damages in the elevator ropes. See, e.g., *In re Fox*, 471 F.2d 1405, 1406-07, 176 USPQ 340, 341 (CCPA 1973).

Moreover, Saito at column 2, lines 58-62, states that:

In operation, the rope is pressed onto the sheave so that the rope is slightly deformed into an oval form in cross-section. This tends to cause wear and deformation of the groove which receives the deformed rope...

In other words, the grooves in the sheave are subject to wear due to the pressure and friction applied by the rope attached to a load (weight). Implicit in this statement is that the rope, which is subject to the same pressure and friction applied to the grooves due to an attached load and/or a bending angle of the rope, is also expected to have the same or similar wear (defects or damages) in time as the grooves in the sheave. Thus, it can be deduced from Saito that it is well known to one of ordinary skill in the art to appropriately

place a sensor so that it monitors and/or detects portions of the rope most likely to be damaged (worn), especially since the whole purpose of using the sensor is to identify damaged or worn portions of the rope.

Even were we to agree with the appellants that the official notice was improper, our conclusion would not be changed. First, as indicated at page 12 of our decision,

The examiner finds, and the appellants do not dispute, that the sensor described in Hirama and/or Yamagami is placed in a location such that it monitors “nearly the entire length of the [elevator] rope “ for any defects.

Where, as here, the appellants define the claimed location of an inspection device (sensor) functionally in terms of monitoring certain unspecified portions of ropes, and the prior art references describe a sensor particularly located to monitor nearly the entire length of ropes, it is reasonable for the examiner to shift the burden to the appellants to prove that the claim language excludes the locations identified by the prior art references. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

Second, as indicated at page 13 of our decision, “the purpose of [using] the sensor described in Hirama and/or Yamagami is to detect defects (worn portions) in the elevator ropes as indicated *supra* to prevent major elevator accidents which could take many lives.” Thus, it is well within the ambit of one of ordinary skill in the art to place the sensor at an optimum location, such as that claimed, so that the sensor can carry out its function of identifying damaged (worn) portions of the ropes. *In re Boesch*, 617 F.2d 272, 276, 205

USPQ 215, 219 (CCPA 1980))("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."); *In re Aller*, 220 F.2d 454, PQ 233, 235 (CCPA 1955)("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.").

The appellants contend that "[b]y asserting that the combination is improper, Applicant necessarily asserted that all conclusions drawn by the Examiner when making the combination (or after making it), are inappropriate." See the Request for Rehearing, page 5. Thus, it is the appellants' position that the examiner's statements regarding what the prior art references teach are improperly treated as undisputed factual findings. *Id.* However, the appellants' position is devoid of any merit.

As indicated in our decision, the examiner made specific findings regarding the teachings of the prior art references. *In re Bell*, 991 F.2d 781, 784, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (What a reference teaches is a question of fact.). However, the appellants have not challenged these findings. See the Brief in its entirety. Thus, we have properly adopted these findings as facts. *In re Baxter Travenol Labs*, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re Kunzmann*, 326 F.2d 424, 425 n.3, 140 USPQ 235, 236 n.3 (CCPA 1964). This is especially true in this instance since substantial evidence supports the examiner's findings as indicated in our decision. Our

decision refers to columns and lines of the prior art, which explicitly or impliedly support the examiner's undisputed factual findings. See the decision in its entirety.

The appellants appear to argue that our decision does not address all of the limitations argued by the appellants. See the Request for Rehearing, pages 12-13. We do not agree.

As stated by the Court of Appeals for the Federal Circuit in *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (2002):

If the brief fails to meet either requirement [as provided under 37 CFR 192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.

Consistent with *McDaniel*, we addressed all of the contested limitations of the selected claims (except for claims 3, 9, 11, 15, 20, 21 and 22) and discussed the dispositive issue applicable those selected claims.¹ See pages 10-13 of our decision and the Answer. After discussing the dispositive issue applicable to the selected claims, we separately addressed all of the contested limitations of claims 3, 9, 11, 15, 20, 21 and 22 at pages 13 through 15 of our decision.

Accordingly, the appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

¹ The appellants have not disputed our grouping of the claims on appeal as set forth at page 10 footnote 1, of the decision. See the Request for Rehearing in its entirety.

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No time period for taking any subsequent action in connection with this appeal may
be extended under 37 CFR § 1.136(a).

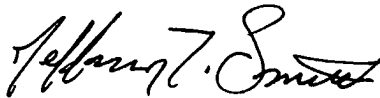
DENIED



BRADLEY R. GARRIS
Administrative Patent Judge



CHUNG K. PAK
Administrative Patent Judge



JEFFREY T. SMITH
Administrative Patent Judge

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Application No. 09/788,481

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